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**FAX TRANSMISSION TO USPTO**

TO: Commissioner for Patents  
Attn: Examiner William D. Hutton,  
Jr.  
Patent Examining Corps  
Facsimile Center  
Alexandria, VA 22313-1450

FROM: George H. Gates  
OUR REF.: SVL920010049US1  
TELEPHONE: (310) 642-4146

Total pages, including cover letter: 7

PTO FAX NUMBER: 571-273-8300

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Title of Document Transmitted:	TRANSMITTAL DOCUMENTS (2) AND PETITION UNDER 37 C.F.R. §1.181
Applicant:	Lee Anne Kowalski
Serial No.:	09/928,599
Filed:	August 13, 2001
Group Art Unit:	2176
Title:	METHOD AND SYSTEM FOR IDENTIFYING AND DISTINGUISHING WORDS CONTAINED WITHIN AN ELECTRONIC MESSAGE IN ORDER TO CONVEY SIGNIFICANCE
Our Ref. No.:	SVL920010049US1

Please charge all fees to Deposit Account No. 09-0460 of IBM Corporation, the assignee of the present application.

By: 

Name: George H. Gates  
Reg. No.: 33,500

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.

  
Signature

25 OCT 2006  
Date

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G&C 30571.266-US-01

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## CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on October 25, 2006.

By: GHG  
Name: George H. Gates

MAIL STOP PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.  
☒ Petition Under 37 C.F.R. §1.181.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.

Please charge all fees to Deposit Account No. 09-0460 of IBM Corporation, the assignee of the present application. A duplicate of this paper is enclosed.

Customer Number 45729  
GATES & COOPER LLP  
Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, CA 90045  
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By:   
Name: George H. Gates

PETITION UNDER 37 C.F.R. §1.181TO INVOKE THE SUPERVISORY AUTHORITY OF THE COMMISSIONER  
CONCERNING THE PREMATURE FINALITY OF THE REJECTIONS AND  
THE SUFFICIENCY AND PROPRIETY OF THE DECLARATIONS

MAIL STOP PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I. Introduction

This Petition is being submitted to invoke the supervisory authority of the Commissioner under 37 C.F.R. §1.181 involving an ex parte action in the above-identified patent application that is not subject to appeal.

Specifically, this Petition is being submitted in accordance with M.P.E.P. §706.07(c) to request a review of the prematurity of the final rejection in the above-identified patent application.

In addition, this Petition is also being submitted in accordance with M.P.E.P. §715.08 to request a review of the sufficiency and propriety of the Declarations under 37 C.F.R. §1.131 submitted in the above-identified patent application.

## II. The Premature Finality of the Rejections

Applicant's attorney requests a review of the final rejections made in an Office Action dated October 5, 2006 for the above-identified patent application. The Office Action is a first Office Action following a Request for Continued Examination (RCE) submitted on July 19, 2006.

The Office Action, on page 53 thereof, states that all claims are drawn to the same invention as claimed prior to the submission of the RCE and Amendment under 37 C.F.R. §1.114, in accordance with M.P.E.P. §706.07(b). Accordingly, the Office Action states that the Office Action is made final even though it is a first Office Action after the filing of the RCE.

Applicant's attorney disagrees.

The Amendment under 37 C.F.R. §1.114 submitted with the RCE significantly amended the independent claims. Indeed, the Office Action itself states, on page 2 thereof, that, in light of Applicant's amendments to claims 1, 23 and 45, the rejections of claims 1, 8-16, 19-23, 30-38, 41-45, 52-60 and 63-66 previously set forth under 35 U.S.C. §103(a) as being unpatentable over Padwick in view of Rand, are withdrawn. This statement by the Office Action contradicts the later statement by the Office Action, on page 53 thereof, that all claims are drawn to the same invention claimed in the application prior to the entry of the Amendment under 37 C.F.R. §1.114.

Moreover, a review of the amended claims shows that they are not drawn to the same invention claimed prior to the RCE and Amendment under 37 C.F.R. §1.114. Indeed, as noted, the amendments to the claims were significant enough for the Office Action to withdraw the previous rejections. Consequently, the finality of the rejection is premature and should be withdrawn.

## III. The Sufficiency and Propriety of the Declarations under 37 C.F.R. §1.131

Applicant's attorney requests a review of the sufficiency and propriety of the Declarations under 37 C.F.R. §1.131 submitted in the application. Specifically, this Petition seeks a review of the following issues.

- (1) Whether the Declaration under 37 C.F.R. §1.131 by Applicant's attorney (George H. Gates) is eligible for consideration in showing diligence in the constructive reduction to practice, and whether such efforts by Applicant's attorney inures to the benefit of the inventor.

Applicant's attorney submits that his Declaration under 37 C.F.R. §1.131 should be considered by the Examiner, as it supplements the Declarations submitted by Lee Anne Kowalski and Jeanette Berry Souza. In this regard, Applicant's attorney incorporates herein the arguments in the Amendment under 37 C.F.R. §1.114 submitted on July 19, 2006. Specifically, M.P.E.P. §2138.04 states that the diligence of the attorney in preparing and filing patent application inures to the benefit of the inventor, notwithstanding the contrary assertions of the Office Action.

Consequently, Applicant's attorney requests that his Declaration be entered and considered.

- (2) Whether the Declarations under 37 C.F.R. §1.131 by Lee Anne Kowalski, Jeanette Berry Souza and George H. Gates are sufficient to establish diligence from prior to the reference date to the filing date of the application.

The Office Action asserts that Kowalski and Souza Declarations fail to establish conception, because neither Declaration points out where each limitation of the claims is proven to exist in the exhibits attached thereto. In this regard, Applicant's attorney incorporates herein the arguments in the Amendment under 37 C.F.R. §1.114 submitted on July 19, 2006. Specifically, on pages 11-16 of the Amendment under 37 C.F.R. §1.114, Applicants' attorney did use the exhibits to the Declaration and specifically pointed out where each limitation of independent claim 1 was shown to exist in the exhibits. The Office Action, on the other hand, asserts that these efforts by Applicant's attorney are insufficient. Applicant's attorney submits that this assertion by the Office Action is erroneous.

The Office Action also asserts that the evidence submitted in the Kowalski and Souza Declarations is insufficient to establish diligence in reduction to practice. In this regard, the Office Action asserts that the facts attested to in the Declarations are not facts, but mere pleadings, and thus do not establish diligence in reduction to practice. Applicant's attorney submits that this assertion by the Office Action is erroneous.

Consequently, Applicant's attorney submits that the Declarations under 37 C.F.R. §1.131 submitted in this application are proper and sufficient to overcome the prior art rejections. Consequently, Applicant's attorney requests that the objections to the Declarations and the corresponding prior art rejections be withdrawn.

IV. Conclusion


This Petition is being submitted by facsimile, and no fee is deemed necessary in connection with the filing of this Petition. However, should the Office determine that a fee is required, the Office is authorized to charge any such fee to the Deposit Account No. 09-0460 of IBM Corporation, the Assignee of the above-identified patent application.

Respectfully submitted,

GATES & COOPER LLP  
Attorneys for Applicant

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Date: October 25, 2006

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